

REMARKS

Claims 3-8, 13-18 and 23-28 are pending in the Application. Claims 3-5, 13-15 and 23-25 are rejected under 35 U.S.C. §102(e). Claims 6-8, 16-18 and 26-28 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner has rejected claims 3-5, 13-15 and 23-25 under 35 U.S.C. §102(e) as being anticipated by Burnhouse et al. (U.S. Patent Application Publication No. 2002/0056104) (hereinafter "Burnhouse"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Burnhouse does not disclose "wherein if said broadcast signals include said tags then the method further comprises the step of: comparing said tags with a list of one or more classifications associated with said plurality of television stations" as recited in claim 3 and similarly in claims 13 and 23. The Examiner cites paragraphs [0036 and 0040] of Burnhouse as disclosing the above-cited claim limitation. Office Action (1/29/2007), page 4. Applicants respectfully traverse.

Burnhouse instead discloses that CPU 29 generates a table of pointers 401 to the EPG stored in the memory. [0036]. Burnhouse further discloses that the table 401 is used for changing the order of channels or programs according to the information to be presented in the guide to the user. [0036]. Burnhouse additionally discloses that using the information downloaded from the satellite transmission, programming and channel selection information is provided to the viewer. [0040]. Hence, Burnhouse discloses a table of pointers used for changing the order of

channels to be presented in a guide to a user. Further, Burnhouse discloses providing programming and channel selection information using the information downloaded from the satellite transmission.

There is no language in the cited passages that discloses comparing tags with a list of one or more classifications. Applicants respectfully request the Examiner to particularly point out in Burnhouse where Burnhouse allegedly discloses a list of classifications that is compared with tags pursuant to 37 C.F.R. §1.104(c)(2). Further, there is no language in the cited passages that discloses comparing tags with a list of one or more classifications associated with a plurality of television stations. Neither is there any language in the cited passages that discloses comparing tags with a list of one or more classifications associated with a plurality of television stations if the broadcast signals include the tags. Thus, Burnhouse does not disclose all of the limitations of claims 3, 13 and 23, and thus Burnhouse does not anticipate claims 3, 13 and 23. M.P.E.P. §2131.

Claims 4-5, 14-15 and 24-25 each recite combinations of features of independent claims 3, 13 and 23, respectively, and hence claims 4-5, 14-15 and 24-25 are not anticipated by Burnhouse for at least the above-stated reasons that claims 3, 13 and 23, respectively, are not anticipated by Burnhouse. Claims 4-5, 14-15 and 24-25 recite additional features, which, in combination with the features of the claims upon which they depend, are not anticipated by Burnhouse.

For example, Burnhouse does not disclose "wherein said one or more folders associated with said one or more classifications for said plurality of television stations on said display are displayed according to a base set if there are no differences between said list of one or more classifications associated with said plurality of television stations and said tags" as recited in claim 4 and similarly in claims 14 and 24. The Examiner cites Figures 3 and 5 and paragraph [0041] of Burnhouse as disclosing the above-cited claim limitation. Office Action (1/29/2007), page 5. Applicants respectfully traverse.

Burnhouse instead discloses that at step 501, a folder-style guide is generated and presented to the user. [0041]. Burnhouse further discloses that the folder-style

guide may display several folders, each folder representative of a different type or category of program. [0041]. Burnhouse additionally discloses that in one embodiment, the designated folder may have a title that indicates the type of program in the folder such as drama, sports, etc. [0041]. Hence, Burnhouse discloses displaying folders, where each folder is representative of a category or type of program.

There is no language in the cited passage or in the description of Figures 3 and 5 that discloses that folders associated with one or more classifications for a plurality of television stations on the display are displayed according to a base set. Neither is there any language in the cited passage or in the description of Figures 3 and 5 that discloses that folders associated with one or more classifications for a plurality of television stations on the display are displayed according to a base set if there are no differences between the list of one or more classifications associated with the plurality of television stations and the tags. Thus, Burnhouse does not disclose all of the limitations of claims 4, 14 and 24, and thus Burnhouse does not anticipate claims 4, 14 and 24. M.P.E.P. §2131.

Applicants further assert that Burnhouse does not disclose "wherein if there are differences between said list of one or more classifications associated with said plurality of television stations and said tags then the method further comprises the steps of: updating said list of one or more classifications associated with said plurality of television stations to become a new base set" as recited in claim 5 and similarly in claims 15 and 25. The Examiner cites paragraph [0036] of Burnhouse as disclosing the above-cited claim limitation. Office Action (1/29/2007), page 5. Applicants respectfully traverse and assert that Burnhouse instead discloses that CPU 29 generates a table of pointers 401 to the EPG stored in the memory. [0036]. Burnhouse further discloses that the table 401 is used for changing the order of channels or programs according to the information to be presented in the guide to the user. [0036]. Hence, Burnhouse discloses a table of pointers where the table is used for changing the order of channels or programs.

There is no language in the cited passage that discloses updating a list of one or more classifications. Instead, Burnhouse simply discloses changing the order of channels. Neither is there any language in the cited passage that discloses updating a list of one or more classifications associated with the plurality of television stations to become a new base set. Neither is there any language in the cited passage that discloses updating a list of one or more classifications associated with the plurality of television stations to become a new base set if there are differences between the list of one or more classifications associated with the plurality of television stations and the tags. Thus, Burnhouse does not disclose all of the limitations of claims 5, 15 and 25, and thus Burnhouse does not anticipate claims 5, 15 and 25. M.P.E.P. §2131.

Applicants further assert that Burnhouse does not disclose "wherein if there are differences between said list of one or more classifications associated with said plurality of television stations and said tags then the method further comprises the steps of:... displaying one or more folders associated with one or more classifications for said plurality of television stations on said display according to said new base set" as recited in claim 5 and similarly in claims 15 and 25. The Examiner cites Figures 9-10 of Burnhouse as disclosing the above-cited claim limitation. Office Action (1/29/2007), page 5. Applicants respectfully traverse and assert that there is no language in the description of Figures 9 and 10 that discloses displaying folders associated with classifications for the television stations on the display according to the new base set. Thus, Burnhouse does not disclose all of the limitations of claims 5, 15 and 25, and thus Burnhouse does not anticipate claims 5, 15 and 25. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Burnhouse, and thus claims 3-5, 13-15 and 23-35 are not anticipated by Burnhouse. M.P.E.P. §2131.

## II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 6, 16 and 26 under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Ismail et al. (U.S. Patent No. 7,146,627) (hereinafter "Ismail"). The Examiner has further rejected claims 7-8, 17-

18 and 27-28 under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy et al. (U.S. Patent Application Publication No. 2004/0034867) (hereinafter "Rashkovskiy"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

A. Claims 6, 16 and 26 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Ismail.

1. Burnhouse and Ismail, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Burnhouse and Ismail, taken singly or in combination, do not teach or suggest "wherein said one or more folders associated with said one or more classifications for said plurality of television stations on said display are displayed according to a base set if said broadcast signals do not include said tags" as recited in claim 6 and similarly in claims 16 and 26. The Examiner cites column 27, lines 41-59; column 31, lines 5-37; and column 33, line 65 – column 34, line 32 of Ismail as teaching the above-cited claim limitation. Office Action (1/29/2007), page 7. Applicants respectfully traverse.

Ismail instead teaches that the subscriber's set top box is a set top box 34 which comprises an EPG memory 36 for storing the EPG data from ISP 16. Column 27, lines 41-43. Ismail further teaches that for example, EPG memory 36 may store one or two weeks of EPG data for selective access by the viewer via a menu of the set top box 34. Column 27, lines 43-45. Ismail additionally teaches a set top box 34 that includes EPG memory 36, template memory 38, text page memory 42, a set top box 700, and a set top processor 702 which reads commands from the vertical blanking interval of the incoming video signal and performs the appropriate action. Column 34, line 33, line 66 – column 35, line 4. Ismail additionally teaches that for example, if the incoming command is a text channel definition or EPG definition command from HEC 14, the appropriate update of bit map 704 is performed. Column 35, lines 4-7. Hence, Ismail teaches storing one or two weeks of electronic program guide ("EPG") data for selective access by the viewer via a menu of the set top box.

There is no language in the cited passages that teaches displaying one or more folders associated with one or more classifications for the plurality of television

stations on the display according to a base set. Neither is there any language in the cited passages that teaches displaying one or more folders associated with one or more classifications for the plurality of television stations on the display according to a base set if the broadcast signals do not include tags. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6, 16 and 26, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Examiner's motivation for modifying Burnhouse with Ismail to include the missing claim limitation of claims 6, 16 and 26 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Burnhouse does not teach displaying one or more folders associated with one or more classifications for the plurality of television stations on the display according to a base set if the broadcast signals do not include the tags, as recited in claim 6 and similarly in claims 16 and 26. Office Action

(1/29/2007), pages 6-7. The Examiner asserts that Ismail teaches the above-cited claim limitation. *Id.* at page 7. The Examiner's motivation for modifying Burnhouse with Ismail to include the above-cited claim limitation is "for the purpose of allowing the viewer's set top box to store one or two weeks of EPG data for selective access by the viewer via a menu of the set top box (see column 27, lines 41-45 of Ismail), which additionally allows acceptable memory costs during manufacture of the set top box (see column 27, lines 58-59 of Ismail), by only transmitting a limited amount of EPG data at a time." *Id.* at page 8. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 6, 16 and 26.

The Examiner' motivation ("for the purpose of allowing the viewer's set top box to store one or two weeks of EPG data for selective access by the viewer via a menu of the set top box (see column 27, lines 41-45 of Ismail), which additionally allows acceptable memory costs during manufacture of the set top box (see column 27, lines 58-59 of Ismail), by only transmitting a limited amount of EPG data at a time") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Burnhouse to include the above-indicated missing claim limitation of claims 6, 16 and 26. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 16 and 26. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites column 27, lines 41-45 and 58-59 of Ismail as support for the Examiner's motivation. Ismail teaches that the subscriber's set top box is a set top box 34 which comprises an EPG memory 36 for storing the EPG data from ISP 16. Column 27, lines 41-43. Ismail further teaches that for example, EPG memory 36 may store one or two weeks of EPG data for selective access by the viewer via a menu of the set top box 34. Column 27, lines 43-45. Ismail further teaches that of course, different set top boxes 34 may have varied amounts of memory and processing capabilities for such purposes in accordance with the acceptable memory costs during manufacture of the set top box 34. Column 27, lines 56-59. Hence, Ismail teaches storing one or two weeks of electronic program guide data. Ismail further teaches that different top boxes may have varied amounts

of memory and processing capabilities for such purposes in accordance with the acceptable memory costs during manufacture of the set top box.

As understood by Applicants, the Examiner asserts that Ismail teaches that because it allows the storage of one to weeks of electronic program guide that this additionally allows acceptable memory costs during the manufacture of the set top box. This is incorrect. Instead, Ismail makes the statement that different set top boxes may have varied amounts of memory and processing capabilities for such purposes in accordance with the acceptable memory costs during manufacture of the set top box. Further, there is no language in Ismail that supports the assertion that Ismail teaches having acceptable memory costs during the manufacture of the top set box by only transmitting a limited amount of EPG data at a time. Hence, column 27, lines 41-45 and 58-59 of Ismail (the passages cited by the Examiner as support for the Examiner's motivation) does not support the Examiner's motivation.

Further, there is no language in Ismail (and in particular column 27, lines 41-45 and 58-59 of Ismail) that makes any suggestion to display one or more folders associated with one or more classifications for the plurality of television stations on the display according to a base set if the broadcast signals do not include the tags (missing claim limitation) in order to allow acceptable memory costs during the manufacture of the set top box by only transmitting a limited amount of EPG data at a time. The Examiner has to provide some rationale connection between the cited passages that is the source of the motivation and the missing claim limitation. The Examiner's source of motivation (column 27, lines 41-45 and 58-59 of Ismail) does not provide reasons as to why one skilled in the art would modify Burnhouse to include the missing claim limitation of claims 6, 16 and 26. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 16 and 26. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Furthermore, Burnhouse addresses the problem of generating a folder guide to generate tailored broadcast system electronic program guides. [0005]. The Examiner has not provided any reasons as to why one skilled in the art would modify Burnhouse (which teaches generating a folder guide to generate tailored broadcast system electronic program guides) to display one or more folders associated with one



or more classifications for the plurality of television stations on the display according to a base set if the broadcast signals do not include the tags (missing claim limitation). The Examiner's motivation ("for the purpose of allowing the viewer's set top box to store one or two weeks of EPG data for selective access by the viewer via a menu of the set top box (see column 27, lines 41-45 of Ismail), which additionally allows acceptable memory costs during manufacture of the set top box (see column 27, lines 58-59 of Ismail), by only transmitting a limited amount of EPG data at a time") does not provide such reasoning.

Why would the reason to modify Burnhouse (whose purpose is to generate a folder guide to generate tailored broadcast system electronic program guides) to display one or more folders associated with one or more classifications for the plurality of television stations on the display according to a base set if the broadcast signals do not include the tags (missing claim limitation) be to allow acceptable memory costs during the manufacture of the set top box? Burnhouse is not concerned with memory costs during the manufacture of the set top box. The Examiner cannot completely ignore the teachings of Burnhouse in concluding it would have been obvious to modify Burnhouse to include the missing claim limitation of claims 6, 16 and 26.<sup>1</sup> Further, how does acceptable memory costs (Examiner's motivation) relate to displaying one or more folders associated with one or more classifications for the

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<sup>1</sup> Applicants respectfully request Examiner Salce to respond to the following example. For example, suppose that the invention of a super soaker gun (essentially a plastic gun that shoots water) was never developed and an Applicant filed for a patent application on the super soaker gun. Applicant claims a plastic gun with a container of water that shoots water. The Examiner cites a primary reference that teaches a plastic gun that shoots darts and cites a secondary reference that teaches a plastic toy that contains a container of water. Since the primary reference does not teach a container filled with water, the Examiner cites the secondary reference as teaching this missing claim limitation. The secondary reference specifically states that the purpose of the container is to carry water. The Examiner then concludes that it would have been obvious to modify the primary reference with the secondary reference in order to carry water. The Examiner believes that he/she has established a *prima facie* case of obviousness since the Examiner has found a reason to have a container of water. However, the Examiner is completely ignoring the teaching of the primary reference. Why would one skilled in the art modify a plastic gun that shoots darts to have a container of water? This is the key question to answer. While having a container of water may be used to carry water, that is irrelevant as far as the purpose of the primary reference. Simply citing to a passage in the secondary reference that discusses the purpose of that secondary reference may not be sufficient evidence for an obviousness rejection. After all, surely there is a reason as to why the secondary reference teaches the missing claim limitation or else why would it include it? The Examiner must explain the connection between the teachings of the primary reference and the rationale of the secondary reference for including the missing claim limitation. Otherwise, everything can be deemed obvious and virtually nothing can be patented.

plurality of television stations on the display according to a base set if the broadcast signals do not include the tags (missing claim limitation)? Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Burnhouse to include the missing claim limitation of claims 6, 16 and 26. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 16 and 26. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

B. Claims 7-8, 17-18 and 27-28 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy.

Applicants respectfully assert that Burnhouse and Rashkovskiy, taken singly or in combination, do not teach or suggest "receiving input to add or delete a particular folder; and adding or deleting said particular folder" as recited in claim 7 and similarly in claims 17 and 27. The Examiner cites Figure 6 and paragraph [0014] of Rashkovskiy as teaching the above-cited claim limitation. Office Action (1/29/2007), page 9. Applicants respectfully traverse and assert that Rashkovskiy instead teaches a graphical user interface 10 for implementing an electronic content guide that includes a plurality of selectable category icons 12 represented as "virtual" file folders. [0014]. Rashkovskiy further teaches that each category icon 12 may be pre-defined or may be user definable. [0014]. Rashkovskiy additionally teaches that category icon 12a is provided for favorite programs, 12b for movies, 12c for currently available programs, 12d for programs available in the next hour, 12e for sports programs, 12f for news and 12g for animal related content. [0014]. Hence, Rashkovskiy teaches an electronic content guide that includes selectable category icons represented as "virtual" file folders. There is no language in the description of Figure 6 or in the cited passage that teaches receiving input to add or delete a particular folder. Neither is there any language in the description of Figure 6 or in the cited passage that teaches adding or deleting a particular folder. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 7, 17 and 27, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Burnhouse and Rashkovskiy, taken singly or in combination, do not teach or suggest "receiving input to add or delete an indication associated with a particular television station associated with a particular folder; and adding or deleting said indication associated with said particular television station associated with said particular folder" as recited in claim 8 and similarly in claims 18 and 28. The Examiner cites paragraph [0020] of Rashkovskiy as teaching the above-cited claim limitations. Office Action (1/29/2007), page 10. Applicants respectfully traverse.

Rashkovskiy instead teaches that the user has selected favorite programs that are currently available in the illustrated example. [0020]. Rashkovskiy further teaches that the basis for defining favorites may be extremely varied. [0020]. Rashkovskiy additionally teaches that the user may simply enter what the user decides at any given instance of time, such as any given day of the week, are his or her favorite programs. [0020]. Furthermore, Rashkovskiy teaches that as another example, the system can automatically discern what are the favorite programs on how frequently the user views a given program over varying time periods. [0020]. Hence, Rashkovskiy teaches allowing the user to select his/her favorite programs.

There is no language in the cited passage that teaches receiving input to add or delete an indication associated with a particular television station. Neither is there any language in the cited passage that teaches receiving input to add or delete an indication associated with a particular television station associated with a particular folder. Neither is there any language in the cited passage that teaches adding or deleting the indication associated with the particular television station. Neither is there any language in the cited passage that teaches adding or deleting the indication associated with the particular television station associated with the particular folder. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 8, 18 and 28, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

III. CONCLUSION:

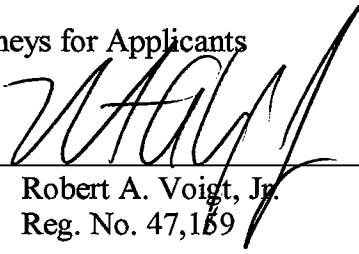
As a result of the foregoing, it is asserted by Applicants that claims 3-8, 13-18 and 23-28 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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